

REMARKS / ARGUMENTS:

The withdrawal from consideration of claims 4 – 12, 21, 22, 47, 49, 56, 58, 73 and 74 is noted. The rejoinder of these claims may be requested at a later stage of the present prosecution.

Claims 2, 14, 46, 52 and 72 have been amended.

Claims 2, 46, 52 and 72 are amended by adding the term “benzothiophene” in the fourth line of the claim. Support for the aromatic ring as a benzothiophene ring can be found at least at original claim 6. The term is added to provide antecedent basis for its description in dependent claims.

Claim 14 is amended to replace the period that appears after the number “13” in the first line of the claim with a comma to correct punctuation.

Claims 46, 52 and 72 are amended as described above and also by the addition of the term “and” in the third line from the end and the fourth line from the end, respectively, in order to clarify the language of the claim.

Claim 72 is also amended to replace the comma at the end of the claim with a period to correct punctuation.

No new matter has been added.

Rejection of claims 1 – 3, 13 – 20, 23, 31, 38 – 41, 71 and 72 under 35 USC §103(a) as obvious over U.S. Patent No. 6,559,136 to Mauler-Machnik *et al.*

It is respectfully requested that the rejection of claims 1 – 3, 13 – 20, 23, 31, 38 – 41, 71 and 72 under 35 USC §103(a) as obvious over U.S. Patent No. 6,559,136 to Mauler-Machnik *et al.* be reconsidered in view of the amendments to the claims and the arguments in favor of patentability that are described below and be withdrawn.

Claim 1, and all claims that depend therefrom, describes a method of increasing the vigor and/or the yield of an agronomic plant by treating the plant or its propagation material with a composition that includes an effective amount of a fungicide which has no significant activity against fungal plant pathogens for the plant.

In order to reject claim 1 as obvious under 35 USC §103(a), the Office must first establish a *prima facie* case of obviousness by showing that the teachings from the prior

art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Rijckaert*, 28 U.S.P.Q.2d, 1955, 1956 (Fed. Cir. 1993).

In the present case, it is maintained that the Office has not established a *prima facie* case of obviousness, because U.S. Patent 6,559,136 does not teach or suggest treating a plant or its propagation material with a fungicide which has no significant activity against fungal plant pathogens for the plant, as is required in claim 1, and in all claims that depend from that claim. In contrast, the cited '136 patent specifically describes its novel compounds as being used "for controlling phytopathogenic fungi...". (Abstract). Moreover, the Office argues that "[o]ne would have been motivated to do this [treat a plant or seed with a claimed fungicide] because both captan and silthiopham are individually taught to control pathogenic fungi on plants."

But, if one's motivation is to control fungi, as both the Office and the cited patent teach, then one would never use a fungicide which has no significant activity against fungal plant pathogens for the plant, as required by the claimed invention. In other words, the cited art would never suggest to one of ordinary skill to practice the claimed method. Without a showing that the prior art suggested the claimed invention to a skilled practitioner, a *prima facie* case of obviousness has not been established. It is respectfully requested, therefore, that the present rejection be reconsidered and be withdrawn.

Provisional, non-statutory double patenting rejection of claims 1 – 3, 13 – 20 and 23 over claims 1, 8 and 23 of copending Application No. US20030060371.

It is respectfully requested that the rejection of claims 1 – 3, 13 – 20 and 23 as being unpatentable over claims 1, 8 and 23 of Application US20030060371 be held in abeyance until the scope of patentable subject matter of the present claims has been determined. At that time, Applicant agrees to provide a Terminal Disclaimer to avoid the effects of the copending application.

Allowability of claims drawn to captan and silthiopham:

The statement that the elected invention comprising captan and silthiopham is not allowable is acknowledged.

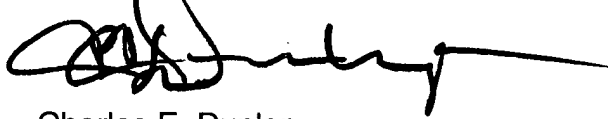
Allowability of claims 36, 37, 42 – 46, 48, 55, 57, 66, 67, 69 and 70:

The allowability claims 36, 37, 42 – 46, 48, 55, 57, 66, 67, 69 and 70 if rewritten in independent form including all of the limitations of the base claim and any intervening claims is acknowledged with appreciation.

Request for reconsideration:

It is respectfully requested that the claims be reconsidered in view of the amendments and after consideration of the reasons for allowability that are discussed above and be found to be allowable. If one or more of the claims are found to not be allowable, a telephone call to the undersigned would be appreciated in order to resolve any remaining issues.

Respectfully submitted,
Nelson Mullins Riley & Scarborough LLP

A handwritten signature in black ink, appearing to read 'Charles E. Dunlap', with a long horizontal flourish extending to the right.

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